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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,470	12/15/2003	Steven Tischer	030536 (BLL-0162)	3487

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One AT&T Way

Bedminster, NJ 07921

EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/736,470	Applicant(s) TISCHER, STEVEN	
	Examiner ADAM LEVINE	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>18 March 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments and remarks filed May 29, 2009, are responsive to the office action mailed March 18, 2009. Claims 1-5, 8-15, and 19-21 were previously pending. Claims 1 and 4-5 are amended. Claims 10-15 and 19-21 have been cancelled. Specification paragraphs 0004-0005 and 0026-0027 are amended and drawing figure 3 is amended. Claims 1-5 and 8-9 therefore remain currently pending and are considered in this office action.

Response to Amendment

Pertaining to objection to the drawings in the previous office action

The drawings filed on October 10, 2008, were objected to because they introduced new matter to the specification. The drawings filed May 29, 2009, have returned the drawings to their previous state and so this objection is withdrawn.

Pertaining to objection to the specification in the previous office action

The amendment filed October 10, 2008, was objected to under 35 U.S.C. 132(a) because it introduced new matter into the disclosure. The amendments have returned the specification to its original state and this rejection is therefore withdrawn.

Pertaining to rejection under 35 USC 112, first paragraph, in the prior office action

Claims 1-5, 8-15, and 19-21 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 10-15 and 19-21 have been cancelled rendering the rejection moot with regard to those claims. The

amendments to the other claims have overcome the basis for this rejection and it is withdrawn.

Response to Arguments

Pertaining to rejection under 35 USC 102(b) in the previous office action

Applicant's arguments filed May 29, 2009, have been fully considered but they are not persuasive. In response to applicant's argument that the prior art "is directed to ranking target profiles for target objects in electronic media as compared to a user's target profiles," while present claim 1 "is directed to formation of the master set of data for that user," rather than "evaluating new items for a match with a user," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The prior art performs the claimed steps. Whether the ultimate goal of the prior art invention goes beyond that claimed presently is irrelevant. Additionally, while arguing that the present claims are not directed to "evaluating new items for a match with a user," applicant then argues that the presently claimed "master data set defines items of interest to the user." While not entirely contradictory, the later characterization is perfectly compatible with the prior art, while the former would only seem to stop short of the prior art in intended functionality. The prior art teaches ranking items of interest to a user based on the users' interests determined by actions of the user. The present claims are "all directed to ranking the user's interests." Ranking items of interest to a user is the same as ranking the user's interests.

Claim Objections

1. **Claim 1 is objected to because of the following informalities:** In line 20, "attributes" should be inserted after "second." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 8 depends from claim 7, but claim 7 has been cancelled. In addition, claim 8 recites, "a fourth network device." This creates confusion because no other "network device" is claimed, i.e., there are no first, second, and third network devices. Even if one were to assume that other devices appearing in the claims were intended to represent network devices, only two other devices have been previously claimed.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-5 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz (Paper # 060324; US Patent No. 6,029,195).**

Herz teaches a method for comparing attributes of multiple data sets to determine similarities and then create new data sets based on the similarities. Herz further teaches:

- determining when the entity selects a first service or product: generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.10); wherein the first data set is generated by a digital video recording device and includes a unique identifier associated with an entity, a date, a time and a title of a program or movie selected by the entity for recording on the digital video recording device (see at least abstract, column 32 line 65-column 33 line 59, column 43 line 53-column 44 line 49, column 39 line 57 – column 40 line 33. Please note: passages show that electronic media includes video and that video recording devices are among the potential devices that generate profile data. Please note: The particular information included in the data set is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); first device configured to determine whether the entity purchases, submits an order for the first service or product (see at least column 5 lines 36-45, column 18 line 40-column 19 line 7, column 68 lines 5-10, column 77 lines 17-47);

- determining when the entity selects a second service or product: generating a second data set having a second attribute associated with the second service or product (see at least abstract); wherein the second data set is generated by a personal computer, the second data set including a unique identifier associated with an entity, a data, a time, and a web address accessed by the personal computer (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65-column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42);
- generating a third data set based on the first and second attributes: when a portion of data associated with the first attribute is substantially similar to a portion of data associated with the second attribute (see at least abstract, figs. 1, 2, 10; column 5 lines 6-20, column 26 lines 2-21);
- generating a master data set in response to the third data set: including a plurality of potential interest elements based on a number of matches between the first and second attributes, and ranking the potential interest elements in the master data set based on the number of matches between the first and second attributes (see at least abstract, figs.10-16; column 2 line 39 – column 3 line 10, column 4 lines 4-27, column 5 lines 5-20, column 6 line 59 – column 7 line 18); a fourth network device generates the master data set (see at least abstract, figs.1,2);
- the data associated with the first attribute comprises textual data: and the data associated with the second attribute comprises textual data (see at least

abstract, column 5 lines 6-20, column 9 lines 19-30, column 77 lines 17-47);
generating the third data set based on the first and second attributes includes
determining whether at least a portion of the textual data of the first attribute is
identical to at least a portion of the textual data of the second attribute and
forming the third data set having a third attribute containing at least a portion of
textual data from one of the first and second attributes (see at least abstract,
column 5 lines 6-20, column 77 lines 17-47);

- entity comprises one of a person or a group of people: (see at least abstract,
column 9 lines 31-42. Please note: the identity of the entity has no functional role
in the method and a person or group of people are themselves not patentable
subject matter.).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

Adam Levine
Patent Examiner
August 2, 2009
/Adam Levine/
Examiner, Art Unit 3625